

### **REMARKS**

Claims 1-24 are pending in the Application. Claims 1, 13 and 24 are independent claims. Claims 2-12 depend from independent claim 1. Claims 14-23 depend from independent claim 13. Claims 13-24 were previously withdrawn from consideration with traverse in response to a restriction/election requirement. The Applicant respectfully requests that the application be reconsidered in view of the foregoing amendments and the following remarks.

#### **Election/Restrictions**

On pages 2-3 of the Office Action, the Examiner indicated that “[b]ecause applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).” (Office Action, Page 2). However, the Applicant did distinctly and specifically point out the errors in the restriction requirement. Specifically, the Applicant noted that “[t]he Applicant traverses this restriction requirement because ‘[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.’ See Manual of Patent Examining Procedure (MPEP) at § 803. The Applicant respectfully submits that the Office Action has not established a *prima facie* serious burden with respect to a **search and examination** of all the claims. Indeed, nowhere does the Office Action even state that such a burden exists. As such, the Applicants have demonstrated that the Office Action has not explained how and why the reasons set forth in the Office Action establish a *prima facie* **serious** burden with respect to the search and examination of the claims of the present application. For at least the reasons discussed above, the Applicant respectfully requests reconsideration of the restriction requirement. Indeed, all of the pending claims of the present application should be examined together due to the fact that the Office Action has not established a *prima facie* showing of a serious burden with respect to the search and examination of these claims.” (Applicant’s Election with Traverse filed April

30, 2010, Page 2, Line 13 – Page 3, Line 3). As such, the Applicant respectfully submits that Applicant's reply was complete pursuant to MPEP § 818.03(a) and that the election made by the Applicant was with traverse. As such, the Applicant respectfully requests reconsideration of the restriction requirement.

**Rejections Under 35 U.S.C. §102(b) – Williams (Claims 1, 3, 7-8 and 11-12)**

On pages 3-4 of the Office Action, independent claim 1 and dependent claims 3, 7-8 and 11-12 were rejected under 35 U.S.C. §102(b) as being anticipated by Williams (U.S. Pat. No. 6,190,395). The Applicant respectfully traverses the rejection for at least the following reasons.

With regard to the anticipation rejections, MPEP 2131 states, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131 also states, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding claim 1, the Applicant respectfully submits that Williams fails to teach, suggest, or disclose, for example, “said **second localizer being movable relative to the area of interest**, said first and **second localizers being movable** in order that **said first and second localizers are in communication** such that the position of one of said first and second localizers is known relative to the position of the other of said first and second localizers,” as set forth in Applicant's independent claim 1.

Williams teaches a tracking head 34 and mounting assembly 44 for a medical instrument 32 that is adjustable such that the medical instrument 32 may be repositioned without interrupting a line of sight between the emitters and/or reflectors 40 of the tracking head 34 and a digital camera 24 or other suitable sensor array. (See e.g., Williams, Figures 1-2; Abstract;

Column 2, Lines 47-58; Column 3, Lines 22-27; Column 4, Line 41-50 and 54-65; and, Column 7, Lines 33-42). Williams also teaches a reference arc 18 mounted on a clamping assembly 16 that clamps onto a patient. The reference arc 18 includes emitters/reflectors 20 that are tracked by the digitized camera 24. (See e.g., Williams, Figure 1 and Column 4, Lines 12-41). The Office Action alleges that Williams' disclosure of the tracking head 34 teaches the first localizer and Williams' disclosure of the reference arc tracking means 18/20 teaches the second localizer. (Office Action, Page 3, Lines 12-19). However, nowhere in Williams is there any teaching that Williams' reference arc tracking means 18/20 is movable relative to the area of interest. Further, nowhere in Williams is there any teaching that Williams' tracking head 34 and Williams' reference arc tracking means 18/20 are in communication. Instead, it is the digitizer camera 24 that tracks the position of both the emitters/reflectors 20 of reference arc 18 and the emitters/reflectors 40 of tracking head 34. (See e.g., Williams, Figure 1; Column 4, Lines 27-32 and 44-47; and, Column 7, Lines 33-37). Because nothing in Williams teaches that Williams' reference arc tracking means 18/20 is movable relative to the area of interest, and because Williams fails to teach that its tracking head 34 communicates with its reference arc tracking means 18/20, Williams cannot disclose "said second localizer being movable relative to the area of interest, said first and second localizers being movable in order that said first and second localizers are in communication such that the position of one of said first and second localizers is known relative to the position of the other of said first and second localizers," as recited in Applicant's independent claim 1. Because the Office Action has failed to show "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" as required for an anticipation rejection under MPEP 2131, the rejection of claim 1 under 35 U.S.C. § 102(b) cannot be maintained.

Therefore, for at least the above stated reasons, Applicant respectfully submits that the Williams reference fails to teach, suggest, or disclose Applicant's invention as set forth in claim 1. The Applicant believes that claim 1 is allowable over Williams. Applicant respectfully submits that claim 1 is an independent claim, and that claims 2-12 depend either directly or indirectly from independent claim 1. Because claims 2-12 depend from claim 1, Applicant respectfully submits that claims 2-12 are allowable over the Williams reference, as well. The

Applicant also submits that each of claims 2-12 is independently allowable. The Applicant respectfully requests, therefore, that the rejection of claims 1, 3, 7-8 and 11-12 under 35 U.S.C. §102(b), be withdrawn.

**Rejections Under 35 U.S.C. §103(a) – Williams and Sati (Claim 2)**

On page 5 of the Office Action, claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Sati et al. (U.S. Pub. No. 2002/0055679, hereinafter “Sati”). The Applicant respectfully submits that claim 2 depends either directly or indirectly from independent claim 1. Applicant believes that claim 1 is allowable over the proposed combination of references, in that Sati fails to overcome the deficiencies of Williams, as set forth above. Because claim 2 depends from independent claim 1, Applicant respectfully submits that claim 2 is allowable over the proposed combination of Williams and Sati, as well. Applicant also asserts that claim 2 is independently allowable. Therefore, for at least the reasons set forth above, Applicant respectfully requests that the rejection of claim 2 under 35 U.S.C. §103(a) be withdrawn.

**Rejections Under 35 U.S.C. §103(a) – Williams and Schenk (Claims 4 and 10)**

On pages 5-7 of the Office Action, claims 4 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Schenk et al. (U.S. Pat. No. 5,895,389, hereinafter “Schenk”). The Applicant respectfully submits that claims 4 and 10 depend either directly or indirectly from independent claim 1. Applicant believes that claim 1 is allowable over the proposed combination of references, in that Schenk fails to overcome the deficiencies of Williams, as set forth above. Because claims 4 and 10 depend from independent claim 1, Applicant respectfully submits that claims 4 and 10 are allowable over the proposed combination of Williams and Schenk, as well. Applicant also asserts that each of claims 4 and 10 is

independently allowable. Therefore, for at least the reasons set forth above, Applicant respectfully requests that the rejection of claims 4 and 10 under 35 U.S.C. §103(a) be withdrawn.

**Rejections Under 35 U.S.C. §103(a) – Williams and Haynes (Claims 5-6)**

On pages 7-9 of the Office Action, claims 5-6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Haynes (U.S. Pat. No. 2,238,870). The Applicant respectfully submits that claims 5-6 depend either directly or indirectly from independent claim 1. Applicant believes that claim 1 is allowable over the proposed combination of references, in that Haynes fails to overcome the deficiencies of Williams, as set forth above. Because claims 5-6 depend from independent claim 1, Applicant respectfully submits that claims 5-6 are allowable over the proposed combination of Williams and Haynes, as well. Applicant also asserts that each of claims 5-6 is independently allowable. Therefore, for at least the reasons set forth above, Applicant respectfully requests that the rejection of claims 5-6 under 35 U.S.C. §103(a) be withdrawn.

**Rejections Under 35 U.S.C. §103(a) – Williams and Davison (Claim 9)**

On pages 9-10 of the Office Action, claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Davison (U.S. Pat. No. 4,710,075, hereinafter “Davison”). The Applicant respectfully submits that claim 9 depends either directly or indirectly from independent claim 1. Applicant believes that claim 1 is allowable over the proposed combination of references, in that Davison fails to overcome the deficiencies of Williams, as set forth above. Because claim 9 depends from independent claim 1, Applicant respectfully submits that claim 9 is allowable over the proposed combination of Williams and Davison, as well. Applicant also asserts that claim 9 is independently allowable. Therefore, for at least the reasons

set forth above, Applicant respectfully requests that the rejection of claim 9 under 35 U.S.C. §103(a) be withdrawn.

### **Final Matters**

The Office Action makes various statements regarding claims 1-24, restriction/elections, 35 U.S.C. § 102(b), 35 U.S.C. § 103(a), the Williams reference, the Sati reference, the Schenk reference, the Haynes reference, Davison reference, one of ordinary skill in the art, etc. that are now moot in view of the above amendments and/or arguments. Thus, the Applicant will not address all of such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Applicant reserves the right to argue additional reasons supporting the allowability of claims 1-24 should the need arise in the future.

**CONCLUSION**

Applicant respectfully submits that that all of claims 1-12 are in condition for allowance, and requests that the application be passed to issue.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge any required fees not paid herewith or credit any overpayment to the Deposit Account of GTC, Account No. 070845.

Dated: October 5, 2010

Respectfully submitted,

/Philip Henry Sheridan/  
Philip Henry Sheridan  
Reg. No. 59,918

McAndrews, Held & Malloy, Ltd.  
500 West Madison Street, 34<sup>th</sup> Floor  
Chicago, Illinois 60661  
(T) 312 775 8000  
(F) 312 775 8100